

## REMARKS

Claims 1-8, 12-18, 20, 21, 27-39, 42, 44, 46, 48, 50, 52, 54, and 56 are pending in the application. Claims 40, 41, 43, 45, 47, 49, 51, 53, 55, and 57 are withdrawn from consideration as being directed to non-elected inventions. In the non-final Office Action of March 8, 2007, the Examiner made the following disposition:

- A.) Rejected claims 1-8, 12-18, 20, 21, 27-39, 42, 44, 46, 48, 50, 52, 54, and 56 under 35 U.S.C. §103(a) as allegedly being unpatentable in view of *Motoki et al.* (US 2005/0076830) ("Motoki '830").
- B.) Provisionally rejected claims 1, 42, 44, 46, 50, 52, 54, and 56 under the judicially created doctrine of obviousness-type double patenting over claims 1, 79, and 80 of copending Application No. 11/148,771.

Applicants respectfully traverse the rejections and address the Examiner's disposition below.

- A.) Rejection of claims 1-8, 12-18, 20, 21, 27-39, 42, 44, 46, 48, 50, 52, 54, and 56 under 35 U.S.C. §103(a) as allegedly being obvious in view of *Motoki et al.* (US 2005/0076830) ("Motoki '830"):

Applicants disagree with the rejection.

*Motoki '830* cannot render obvious claims 1-8, 12-18, 20, 21, 27-39, 42, 44, 46, 48, 50, 52, 54, and 56, because *Motoki '830* is not a proper reference under 35 U.S.C. §102. Specifically, *Motoki '830* is at best a potential reference under 35 U.S.C. §102(e). Yet Applicants' claimed invention has an invention date that is at least as early as October 12, 2001, which is before *Motoki '830*'s earliest effective U.S. filing date of October 8, 2002.

Applicants' present application was filed in the U.S. on March 30, 2004. The present application and JP 2001-315705 share the same inventors. The subject matter claimed in claims 1-8, 12-18, 20, 21, 27-39, 42, 44, 46, 48, 50, 52, 54, and 56 of the present application was disclosed in JP 2001-315705, which was filed in Japan on October 12, 2001. Therefore, the subject matter of claims 1-8, 12-18, 20, 21, 27-39, 42, 44, 46, 48, 50, 52, 54, and 56 was conceived and constructively reduced to practice at least as early October 12, 2001, which is the filing date of JP 2001-315705.

Japanese patent application JP 2001-315705 published on April 25, 2003 as publication number JP 2003-124115. Thus, the present application was filed in the U.S. within one year of the publication date of JP 2001-315705 in Japan.

Applicants will submit separately herefrom an affidavit under 35 C.F.R. §1.131, which provides additional information and support for Applicants' conception and constructive reduction to practice date at least as early as October 12, 2001. Applicants will also submit a certified translation of JP 2001-315705 when it becomes available.

In the meantime, Applicants note that JP 2001-315705 and a machine-generated translation of its abstract have already been made of record in the present application. The JP '705 application discloses a method of producing a device having a structured substrate including stripe-shaped second regions that are arranged in parallel in a first region made of crystal. (See, e.g., Figure 25 of the JP '705 application, illustrative stripe-shaped second regions B arranged in parallel in first region A). The second regions have an average dislocation density that is greater than the average dislocation density of the first region. (See, e.g., machine-generated translation of abstract of JP '705 application, average dislocation density of second regions B is greater than average dislocation density of first region A).

Accordingly, because Applicants' have an invention date that is at least as early as October 12, 2001, which is before *Motoki* '830's earliest effective U.S. filing date of October 8, 2002, *Motoki* '830 cannot be used as a reference to render obvious Applicants' claimed invention.

Applicants respectfully submit the rejection has been overcome and request that it be withdrawn.

B.) Provisional rejection of claims 1, 42, 44, 46, 50, 52, 54, and 56 under the judicially created doctrine of obviousness-type double patenting over claims 1, 79, and 80 of copending Application No. 11/148,771:

Regarding claims 46, 50, and 54, this provisional rejection is traversed.

For double patenting to occur, there must be a two-way reading of the claims on the same subject matter. Here however, claims 46, 50 and 54 require stripe-shaped second regions being arranged at a first interval in a first direction and at a second interval in a second direction perpendicular to the first direction, in which the second interval is smaller than the first interval. An illustrative example of this claimed subject matter can be found for example in Figure 12. Claims 1, 79, and 80 of Application No. 11/148,771 do not require this. Thus one could infringe claims of Application No. 11/148,771 without infringing claims 46, 50 and 54 of the present application. Therefore, the two-way test is not met and the provisional double patenting rejection is incorrect and should be withdrawn.

Regarding claims 1, 42, 44, 52, and 56, as the rejection is merely provisional, Applicants believe that it is premature to file a terminal disclaimer at this time.

CONCLUSION

In view of the foregoing, it is submitted that claims 1-8, 12-18, 20, 21, 27-39, 42, 44, 46, 48, 50, 52, 54, and 56 are patentable. It is therefore submitted that the application is in condition for allowance. Notice to that effect is respectfully requested.

Respectfully submitted,

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